



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/730,564	12/28/2012	Anantha Pradeep	20225/017US03	3602

81905 7590 02/02/2018  
Hanley, Flight & Zimmerman, LLC (Nielsen)  
150 S. Wacker Dr. Suite 2200  
Chicago, IL 60606

EXAMINER
----------

TROTTER, SCOTT S

ART UNIT	PAPER NUMBER
----------	--------------

3696

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/02/2018

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jflight@hfzlaw.com  
mhanley@hfzlaw.com  
docketing@hfzlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* ANANTHA PRADEEP, ROBERT T. KNIGHT,  
and  
RAMACHANDRAN GURUMOORTHY

---

Appeal 2016-006360  
Application 13/730,564  
Technology Center 3600

---

Before CARLA M. KRIVAK, HUNG H. BUI, and  
DAVID J. CUTITTA II, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 2–7, 9–20, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## STATEMENT OF THE CASE

Appellants' invention is directed to "selection and meta-tagging of advertisement breaks" (Spec. ¶ 2).

Independent claim 2, reproduced below, is exemplary of the subject matter on appeal.

2. A method comprising:

analyzing first neuro-response data gathered from a first subject exposed to source material to determine a first resonance of the first subject to a first portion of the source material and a second resonance of the first subject to a second portion of the source material, the first neuro-response data including two frequency bands of electroencephalographic data and the first resonance based on a coherence between the two frequency bands;

identifying, using a processor, a first priming level of the first portion of the source material based on a first attribute of the source material and the first resonance; and

identifying, using the processor, a second priming level of the second portion of the source material based on a second attribute of the source material and the second resonance; and

selecting (a) the first portion of the source material or (b) the second portion of the source material for inclusion of an advertisement based on the first priming level and the second priming level.

## REFERENCES and REJECTIONS

The Examiner rejected claims 2–7, 9–20, and 22 under a non-statutory obviousness-type double patenting over claims 1–21 of US 8,392,255.<sup>1</sup>

---

<sup>1</sup> The Examiner rejected claims 1–21 under the double patenting rejection (Final Act. 3; Ans. 3). However, as Appellants correctly set forth in their Appeal Brief, it is claims 2–7, 9–20, and 22, that are rejected as claims 1, 8, and 21 were cancelled (App. Br. 2). We consider the Examiner's recitation of incorrect claims as harmless error.

The Examiner rejected claims 2–7, 9–20, and 22 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

### ANALYSIS

With respect to the non-statutory obviousness-type double patenting rejection, we summarily sustain this rejection as no arguments have been submitted nor has a terminal disclaimer been filed.

#### *35 U.S.C. § 101*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible applications of those concepts,” such as an abstract idea. The Court acknowledged in *Mayo* that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 132 S. Ct. at 1293. We, therefore, look to whether the claims focus on a specific means or method that

improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

*Alice/Mayo—Step 1*

Turning to the first part of the *Alice/Mayo* analysis, the Examiner concludes claim 2 is directed to “the abstract idea of analyzing neuro-response data to select source material for inclusion as part of an advertisement” (Final Act. 4). The Examiner also concludes the steps of identifying and selecting in conjunction with the analyzing results in “1) collecting data, 2) analyzing data within the collected data set, and 3) providing the analysis based on that data,” which can all be performed by humans, and are thus, abstract. (Ans. 5).

Appellants contend the Examiner erred in rejecting claims 2–7, 9–20, and 22 under 35 U.S.C. §101 as directed to non-statutory subject matter because the claims amount to more than an abstract idea (App. Br. 13) and the Examiner uses overbroad reasoning (App. Br. 15).<sup>2</sup> However, the

---

<sup>2</sup> Appellants argue independent claims 11 and 16 separately (App. Br. 36–39; note page 36 recites claim 16, however, claim 11 is argued on pages 36–38). As claim 11 provides no new arguments and claim 16 was argued for the same reasons as claim 2, our analysis is directed to claim 2.

Examiner concludes, and we agree, the claims are “functionally ‘organizing information through mathematical correlations,’” and are, thus, abstract.

(Ans. 5).

Appellants argue the claims are not directed to an abstract idea because the alleged abstract idea of “analyzing neuro–response data . . . is not similar to any of the concepts the courts have identified as abstract ideas” (App. Br. 14). We note, however, that the examples set forth in the Interim Guidance are just that, examples. Further, the claims are directed to collecting and analyzing data, which is an abstract idea. We observe that a number of Federal Circuit cases have found claims that simply manipulate data ineligible, like those at issue here, *see, e.g., FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1097–98 (Fed. Cir. 2016) (“the practices of collecting, analyzing, and displaying data, with nothing more, are practices ‘whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas’”) (quotation omitted); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (“we continue to treat analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category”) (quotation omitted); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (“Merely requiring the selection and manipulation of information—provide a ‘humanly comprehensible’ amount of information useful for users—by itself does not transform the otherwise-abstract processes of information collection and analysis.”) (citation omitted).

Appellants further contend the Examiner’s analysis is based on an abstract idea and not the claims as a whole. However, as noted above, we

agree claim 2 is directed to analyzing, identifying, and then making a selection based on the analysis and identification. Appellants' claims do not demonstrate how the data was obtained beyond merely using generic computer technology to perform routine calculations, or what the improvement is in their analysis, identification, and selection steps.

Appellants also require “actual evidence” of the abstract idea, which they state the Examiner has not provided (App. Br. 32) and assert the Examiner failed to establish a prima-facie case (App. Br. 33). Actual evidence, however, is not required in a §101 rejection (*see, e.g.*, para. IV “July 2015 Update: Subject Matter Eligibility” to 2014 Interim Guidance on Subject Matter Eligibility (2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings”)). Evidence may be helpful in certain situations where, for instance, facts are in dispute. As no facts are in dispute in the present case, evidence is not necessary.

To the extent Appellants suggest that the July 2015 Update (or the May 2016 Memorandum) requires particular steps performed in specific ways to establish that a claim is directed to an abstract idea, i.e., a “prima facie” case, Appellants are mistaken (App. Br. 33). Rather, 35 U.S.C. § 132 sets forth a more general notice requirement whereby the applicant is notified of the reasons for a rejection together with such information as may be useful in judging the propriety of continuing with prosecution of the

application (*see, e.g., In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011); *see also* July 2015 Update 6 (setting forth a general notice requirement whereby the Examiner should “clearly articulat[e] the reason(s) why the claimed invention is not eligible” when rejecting on under 35 U.S.C. § 101); May 2016 Memorandum 2 (“the rejection . . . must provide an explanation . . . which [is] sufficiently clear and specific to provide applicant sufficient notice of the reasons for ineligibility”) (emphasis added)). In the instant case, we find the Examiner has provided an adequate explanation to meet said notice requirement. Additionally, we find the Examiner does “focus on the claims as a whole” contrary to Appellants’ contentions (App. Br. 17; Ans. 5–6).

*Alice/Mayo—Step 2*

Appellants also allege the claims “do not seek to tie up the judicial exception” of monopolizing a fundamental building block of science or technology (App. Br. 18, 17). We do not agree. The claim recites “analyzing first neuro-response data” which is just that—data. Appellants cite *Alice*’s cite to *Diamond v. Diehr*, 450 US 175, stating “claim 2 is similar to the situation presented in *Diehr* in that it improves a technological process” and the words of the claims have been ignored (App. Br. 25–26). As Appellants point out, *Diehr* used a well-known equation in a novel manner “in a process designed to solve a technological problem” (emphasis omitted) (App. Br. 25). In the instant case, Appellants have not presented what technological problem is being solved; the claim merely recites selecting a portion of source material to be included in an advertisement based on priming levels.



Appellants argue the claim “provides valuable and comprehensive information to, for example, advertisers with respect to selecting a location in a source material for insertion of an advertisement to maximize the effectiveness of the advertisement in view of the source material and the subject’s neurological responses to the source material” (App. Br. 25). Appellants, however, do not appear to claim how the analyzing, identifying, and selecting steps include “comprehensive information” given that first and second priming levels are identified and then one of either the first portion or second portion is selected for inclusion, with no indication of how or why the particular portion is selected. Appellants also provide no evidence as to how their invention is “an important technological improvement” (App. Br. 27–31). We note using neuro-response data for influencing advertisements is known, and thus, is not new (*see* WO 2011062795 A1, Advertisement Exchange Using Neuro-Response Data, having a priority date of Nov. 9, 2009). We also agree with the Examiner the “electroencephalographic data is data being gathered in an ordinary way for such data so it is not something more” (as the “scanner in *CET vs. Wells Fargo* was not something more”) (Ans. 5–6).

Appellants’ argument that their computer implemented process does more than perform generic functions is also without merit because the process, as the Examiner correctly finds, merely analyzes, identifies, and selects. These are well understood, routine, and conventional functions—nothing more than routine data manipulation (App. Br. 31; Ans. 5).

Because we agree with the Examiner’s analysis and find Appellants’ arguments insufficient to show error, we sustain the rejection of claims 2, 10–20, 21, and 22 under 35 U.S.C. § 101.

*Claims 3–7 and 9*

Appellants contend claim 3–7 and 9 recite “substantially more than the alleged abstract idea” (App. Br. 33–36). We do not agree.

The dependent claims describe various steps of analyzing, appraising, and separating, which do little to patentably transform the abstract idea (*cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016) (“These claims depend from independent claims which were found to be directed to unpatentable subject matter, as discussed above. Merely appending this preexisting practice to those independent claims does not make them patentable. It is an insignificant post-solution activity.”) Further, where all claims are directed to the same abstract idea, “addressing each claim of the asserted patents . . . [is] unnecessary” (*see, Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014).

Because we agree with the Examiner’s analysis and find Appellants’ arguments insufficient to show error, we sustain the rejection of claims 3–7 and 9 under 35 U.S.C. § 101.

DECISION

The Examiner’s decision rejecting claims 2–7, 9–20, and 22 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED